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IN THE UNITED STATES PATENT & TRADEMARK OFFICE

IN RE APPLICATION OF	:	
Yuuichi HIRANO et al.	:	EXAMINER: T. TRAN
SERIAL NO: 09/802, 886	:	
FILED: March 12, 2001	:	GROUP ART UNIT: 2811
FOR: SEMICONDUCTOR DEVICE AND METHOD OF MANUFACTURING THE SAME	:	

PROVISIONAL ELECTION

ASSISTANT COMMISSIONER FOR PATENTS
WASHINGTON, D.C. 20231

SIR:

In response to the Restriction and Election of Species Requirement dated January 25, 2002, the Applicants hereby elect, with traverse, Group I comprising Claims 1-13 for examination on the merits in the present application. Regarding the further Restriction Requirement directed to allegedly patentably distinct species, the Applicants elect, with traverse, the species corresponding to Claims 1 and 4-6, as discussed below. Applicants make this election based on the understanding that Applicants are not prejudiced against filing one or more divisional applications that cover the non-elected claims.

Regarding the Restriction Requirement between Groups I and II, Applicants respectfully traverse this Restriction Requirement for the reason that the inventions of Groups I and II have not been shown to be distinct as required by M.P.E.P. §806.05(f). For a proper Restriction, the M.P.E.P. requires the Patent Office to demonstrate either (1) that the process as claimed is not an obvious process of making the product and the process as claimed can be used to make other and different products, or (2) that the product as claimed

can be made by another and materially different process.

Page 2 of the Restriction Requirement contends that "the device of the group I invention could be made by processes different from those of the group II invention [such as] forming the first complete isolation insulating film before forming the semiconductor layer." As a preliminary matter, it is noted that Claim 14--if this is the claim referred to in the Office Action--actually recites "forming a first complete-isolation insulating film so as to extend from said main surface of said semiconductor layer," instead of the above-quoted language from the Office Action. Further, although one step possibly relating to semiconductors is mentioned in the Office Action, the specific steps of a "materially different" process are not set forth. Because the required showing as to a process, and not just a single step, has not been set forth, Applicants cannot determine what the process being proposed is, much less if it is simply different from the process of Group II or if it is "materially different," as is required.

Since the Restriction Requirement fails to set forth a complete process, it not considered to have met the requirement of MPEP §806.05(f) for showing a "materially different process" for making the product. In this regard, the outstanding restriction fails to take into account the language in Claim 14 involving, among other things, "doping a region for forming the drain region with a first conductivity type-impurity."

Furthermore, MPEP § 803 states the following:

> If the search and examination of an entire application can be made without serious burden, the Examiner must examine it on the merits, even though it includes claims to distinct or independent inventions.

Although the Office Action has identified separate classifications, and contends that a *prima face* case of a serious burden has been met, it is respectfully submitted that there is no serious burden in searching and examining all pending claims of the entire application. Since

searching in the semiconductor arts is commonly performed using electronic search tools, a search may be made of a large number of, or theoretically all, subclasses with little or no additional effort. As patents and other publications in this art often contain descriptions of both a process and the apparatus implementing the process, information as to both process and apparatus can be found in the same publication. It is thus very likely that patents and publications in the field of the claimed process will have descriptions of the apparatus in which the process is implemented, greatly facilitating the prior art search and the consideration of both apparatus and process claims. Consequently, it is respectfully submitted that a case of a serious burden has been met in the pending claims of the present application.

Accordingly, Applicants respectfully traverse the Restriction Requirement on the grounds that a search and examination of the entire application would not place a *serious* burden on the Examiner. On the other hand, it would be a more serious burden on Applicants to prosecute and maintain separate applications on the restricted inventions. Therefore, it is respectfully requested that the requirement to elect a single group be withdrawn, and that a full examination on the merits of Claims 1-20 be conducted.

Regarding the various species of the present invention alleged in Office Action at page 3, it is submitted that species 1-3 correspond to Claim 1, and species 6 corresponds to Claims 4-6. These species are mutually related in that an isolation insulating film of complete-isolation type is formed below a line, e.g., a power supply line, a ground line or a signal line. Accordingly, it is submitted that alleged species 1-3 and 6 inherently comprise a single species for examination purposes, and have therefore Claims 1 and 4-6 been provisionally elected.

In light of the above, a full examination on the merits of Claims 1-13 is hereby requested. In the event that issues arise in the application which may readily be resolved by telephone, the Examiner is kindly invited to contact the undersigned attorney at the telephone number listed below.

Respectfully submitted,

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